



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,196	03/10/2005	Wataru Karasawa	08072.0004-00000	1111

22852 7590 11/26/2007
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

ALMATRAHI, FARIS S

ART UNIT	PAPER NUMBER
----------	--------------

3627

MAIL DATE	DELIVERY MODE
-----------	---------------

11/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,196

Applicant(s)

KARASAWA, WATARU

Examiner

Faris Almatrahi

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :03/10/2005, 04/18/2005, 09/26/2005.

DETAILED ACTION

Status of the Application

1. **Claims 1-8** are pending in this application.
2. If applicant is aware of any prior art or any co-pending application not already on record, the applicant is reminded of his/her duty under 37 C.F.R §1.56 to disclose the same.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-8** are rejected under 35 U.S.C. 102(e) as being anticipated by Fukushima et al. (US Patent No. 7,065,570 B2).
5. Regarding Claims 1 and 5, Fukushima discloses a system and method for determining an amount of payment for a maintenance service for a machine (15), comprising: a quantifying step (S42) of quantifying productivity of said machine (15) in a predetermined service period (Abstract, Column 3 lines 36-67); a comparing step (S43) of comparing the productivity quantified in said quantifying step (S42) with a

Art Unit: 3627

predetermined productivity reference and calculating a difference between them (Abstract, Figure 15, Column 5 lines 24-50); and a charge amount determining step (S45) of determining a charge amount for said maintenance service in said service period based on the difference calculated in said comparing step (S43) (Abstract, Figure 15, Column 6 lines 4-50, Column 19 line 59 – Column 20 line 19).

6. Regarding Claims 2 and 6, Fukushima discloses a system and method comprising a productivity reference determining step (S14) of determining said productivity reference by operating said machine (15) during a predetermined preliminary period and quantifying productivity of said machine (15) in said preliminary period (Abstract, Figure 15, Column 2 lines 54-63, Column 6 lines 4-50, Column 19 line 59 – Column 20 line 19).

7. Regarding Claims 3 and 7, Fukushima discloses a system and method wherein in said quantifying step (S42), the productivity of said machine (15) is quantified based on at least one of availability, uptime, and an amount of production (Abstract, Figure 15, Figure 17, Column 19 line 59 – Column 20 line 19).

8. Regarding Claims 4 and 8, Fukushima discloses a system and method wherein in said charge amount determining step (S45), the charge amount is determined by multiplying the calculated difference by a predetermined conversion rate (Abstract, Column 17 lines 14-45).

9. The information disclosure statement filed March 10, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the non-patent literature

Art Unit: 3627

document submitted for consideration did not contain an English translation (Documents not considered in the Information Disclosure Statement are crossed out). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571) 270-3326. The examiner can normally be reached on Monday to Thursday 8AM-4:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Faris Almatrahi
Examiner
Art Unit 3627

FA

 11/21/07
F. RYAN ZEENDER
SUPERVISORY PATENT EXAMINER